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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
Oshima, et. al.
Application No. 09/244,037
Filed: February 4, 1999
Attorney Docket No. 169/MU-1296/

DECISION GRANTING
PETITION UNDER
37 CFR §1.183

This is a decision on the June 3, 2004, "Petition Under 37 CFR 1.183 to Accept Substitute Specification in Reissue Application" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application. The petition is being treated pursuant to 37 CFR 1.183 for waiver of 37 CFR 1.173(a)(1) in addition to waiver of 37 CFR 1.125(d).

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is granted.

A fee of \$130.00 has been charged to Deposit Account No. 23-0975 for the petition under 37 CFR 1.183, as authorized by the petition on page 1.

DECISION

37 CFR 1.125(d) prohibits the filing of a substitute specification in a reissue application, while the present petition requests entry of the substitute specification filed on September 29, 2003. Accordingly, this petition is being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.125(d). 37 CFR 1.173(a)(1) requires the filing of the specification in the form of "a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." The substitute specification filed on September 29, 2003 is not a copy of the printed patent, in double column format. Accordingly, this petition is also being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.173(a)(1).

The reissue application was originally filed with a specification that did not comply with 37 CFR 1.173(a)(1). On September 29, 2003, a substitute specification was filed together with a supplemental amendment. Within the "REMARKS" section of the supplemental amendment, applicant states: "In item 2 on page 2 of the Office Action," (i.e., referencing the Office action mailed on July 29, 2003) "the Examiner required a substitute specification. Thus, the present amendment seeks to amend the specification by replacing the specification with the enclosed

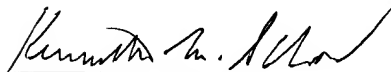
substitute specification.” No further comments by the examiner, regarding the substitute specification, are noted in the application.

Petitioner is requesting waiver of the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) based on the fact that “...the Examiner required a substitute specification because of the length of the specification and the number of amendments..”. It is noted that within the Office action mailed July 29, 2003 and specifically within paragraph two, the examiner states “A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because the extent of amendments renders it difficult to be entered.”

This basis is considered to be sufficient for granting the petition. The rule will be waived to comply with the requirement of the examiner, since there is no other way to present the required substitute specification, and the requirement for the substitute specification by the examiner is deemed appropriate.

CONCLUSION

1. The request under 37 CFR 1.183 to waive the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is granted.
2. The substitute specification filed on June 30, 2003 is accepted, and will be entered.
3. The reissue application file is being forwarded to the Technology Center for further action as appropriate.
4. Telephone inquiries with regard to this decision should be directed to Dwayne D. Bost, TC2600 SPRE, at (703) 305-4778.



Kenneth M. Schor
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